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Marc Husemann

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EXAMINER

DESAI, ANISH P

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

1. **Continuation of Box 11:**

2. It is noted that applicant has submitted a declaration under 37 CFR 1.132 by Mr. Marc Husemann in order to overcome 103(a) rejections as set forth on page 3, section 7 of the Final Office action (FOA) mailed on 03/04/10. While, the Examiner appreciates the declaration and applicant's arguments on pages 6-7 of the after-final amendment incorporating the arguments presented in the declaration, it is respectfully noted that the declaration and applicant's arguments are not found persuasive for the following reasons:

3. In sections 4-7 of the declaration, Mr. Husemann has stated that it was expected that the combination of the claimed monomer and aluminum (III) acetylacetonate (hereinafter "AAc") could not be crosslinked homogeneously and would not be suitable as a PSA, because the polymer forming the PSA is apolar due to the presence of isobornyl acrylate monomer whereas AAc is polar. However, surprisingly, the adhesive did achieve a sufficiently homogeneous crosslink. Further, it is asserted in the declaration that "Furthermore, at the time of the invention, a person of ordinary skill in the art would have expected...having permanent adhesion, and not suitable for removability." (see section 6 of the declaration). Additionally, it is stated in the

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declaration that "It was therefore surprising that the presently claimed adhesive exhibited low wetting behavior, and was able to be easily removed from a surface."

4. The Examiner submits that the aforementioned arguments are not commensurate in scope with the scope of the presently claimed invention. Claims do not require e.g. adhesive having homogenous crosslink and/or ease in removability from a surface. The Examiner respectfully reminds applicant that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

5. Moreover, the Examiner notes that even if applicant's claim were to recite homogenous crosslink and/or removability of the PSA from a surface, the declaration would not have been persuasive, given that the declaration fails to show any data in support of applicant's assertion in sections 5-6 of the declaration. Further, while claimed invention recites bond strength, there are no numerical values of a bond strength presented in claims, other than reciting a tolerance range at a peel rate (see claim 1). Further, the Examiner notes that evidence must show that the results are indeed unexpected (see MPEP 716.02).

6. Based on the above, applicant's arguments including the aforementioned declaration are not found persuasive in overcoming the prior art rejections of record.

7. With respect to applicant's arguments on page 8 of the after-final amendment (see first full paragraph), the Examiner submits that applicant's arguments relating to the

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adhesive with suitable removability are not commensurate in scope with the scope of the presently claimed invention.

8. As to applicant's arguments on page 8 of the after-final amendment (see second full paragraph), the Examiner submits following:

9. Applicant's arguments are not found persuasive given that they are based on applicant's personal opinion and without any factual evidence showing why one can not be motivated to modify Maruoka. Specifically, it is noted that Maruoka's invention generally discloses monomers including isobornyl acrylate (column 5 line 56). While Maruoka does not specifically disclose of using isobornyl acrylate, as stated in the FOA (see page 4, section 10), Spada not only discloses isobornyl acrylate monomer but provides a motivation of using isobornyl acrylate. As such, Spada is relied upon to render obvious isobornyl acrylate monomer. Further, given that Maruoka discloses that one can add crosslinking agents (see column 10 lines 33-34), one of ordinary skill in the art would have to look for a suitable crosslinking agent. McLaughlin reference discloses a suitable crosslinking agent such as that of claimed by applicant (see column 7 lines 5-10). Given that McLaughlin and Maruoka both generally disclose acrylic adhesives, one would be motivated with reasonable expectation of success (unless applicant proves it otherwise) to add the crosslinking agent including that of the presently claimed

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in the acrylic PSA of Maruoka, in order to provide PSA with suitable cohesiveness and Maruoka desires crosslinking agents to his adhesive.

10. Based on the above, applicant's arguments are not found persuasive.

/A. D./

Examiner, Art Unit 1787

/Callie E. Shosho/

Supervisory Patent Examiner, Art Unit 1787